

REMARKS/ARGUMENTS:

No claims are amended or canceled by the present Response. No new matter has been added. Claims 1, 3 – 9 and 11 are pending in the application, with claims 1 and 9 being independent.

Applicants have carefully considered the contents of the Office Action and respectfully request reconsideration and reexamination of the subject application in view of the explanations noted below.

Rejections under 35 U.S.C. § 103(a)

Claims 1, 3 – 6, 9 and 11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,913,095 to Takashima et al. (the Takashima '095 patent) in view of U.S. Patent No. 5,118,093 to Makiura et al. (the Makiura '093 patent). Applicants respectfully traverse this rejection, since the Takashima '095 patent in view of the Makiura '093 patent clearly does not disclose, teach or render obvious the subject matter of claims 1, 3 – 6, 9 and 11.

Independent claims 1 and 9 each recite, inter alia, a paper discharge tray that forms a substantial portion of the rear wall of the main machine, as shown in FIGS. 2 and 3.

U.S. Patent No. 5,913,095 to Takashima et al. discloses an image forming apparatus having a paper stacking means for stacking papers thereon. Three different embodiments are shown in FIGS. 4 – 6, 8 and 9.

In a first embodiment of the Takashima '095 patent, as shown in FIGS. 4 – 6, a paper discharge tray 10 is formed *in* the rear portion of the copier. Col. 3, lines 34 – 36. The paper discharge tray 5 has upper and lower trays 9 and 10 affixed to the upper and lower casings, respectively. Col. 3, lines 40 – 42. Furthermore, the paper discharge tray 10 is fixedly attached to the upper casing part 1, such that the upper tray 10 pivots with the upper casing part 1.

In a second embodiment of the Takashima '095 patent, as shown in FIGS. 7 – 8, the paper discharge trays 40 and 42 are disposed *in* the rear portion of the casing. Col. 5, lines 19 – 20. Furthermore, the upper edge portion of the paper stack in the tray 42, rather than the

discharge tray 42, is allowed to protrude from the top 30a of the upper casing part 30 to facilitate picking up the discharged paper.

In a third embodiment of the Takashima '095 patent, as shown in FIG. 9, the stacking means includes a lower tray 40 and a movable tray portion 21 rotatable around a shaft 23 relative to the lower tray. When papers that are long in the paper discharge direction are discharged, the movable tray portion 21 is rotated clockwise to lower the movable tray portion to prevent the stacked papers P from collapsing. Similarly to the first embodiment, the movable tray portion 21 is formed *in* the rear portion of the copier.

The Makiura '093 patent is cited for disclosing a tray that extends above an upper wall 112 of the main body 2 of the image forming apparatus, as shown in FIG. 1. The tray 114 rotates between an open position shown in solid lines and a closed position shown in dashed lines. In the open position, the tray 114 extends above the upper wall 112 of the main body 2 of the image forming apparatus.

With regard to the first embodiment shown in FIGS. 4 – 6, the Takashima '095 patent does not disclose or suggest a paper discharge tray that forms a substantial portion of the rear wall of the apparatus, as recited in independent claims 1 and 9. As noted above, the Takashima '095 patent discloses a discharge paper tray that is disposed *within* the copier (FIGS. 5 and 6). Col. 3, lines 34 – 36. The discharge tray 10 is disposed *within* the copier, such that the discharge tray does not form a substantial portion of the rear wall of the main machine, as recited in independent claims 1 and 9. Furthermore, the Makiura '093 patent does not cure this deficiency in the first embodiment of the Takashima '095 patent as the tray 114 does not form a substantial portion of a rear wall of the main machine.

With regard to the second embodiment shown in FIGS. 7 – 8, the Takashima '095 patent does not disclose or suggest a paper discharge tray that forms a substantial portion of the rear wall of the apparatus, as recited in independent claims 1 and 9. Similarly to the discharge tray of the first embodiment, the discharge tray 42 shown in FIG. 8 is disposed *in* the rear portion of the casing. Col. 5, lines 19 – 20. By forming the discharge tray 42 *within* the rear portion of the casing, the discharge tray 42 does not form a substantial portion of the rear wall of the main machine, as recited in independent claims 1 and 9. Furthermore, the

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Makiura '093 patent does not cure this deficiency in the first embodiment of the Takashima '095 patent as the tray 114 does not form a substantial portion of a rear wall of the main machine.

Moreover, the Takashima '095 patent does not disclose or suggest a paper discharge tray that extends upwardly higher than the scanner as recited in independent claim 1. As clearly described at col. 6, lines 2 – 5, the “upper edge portion of the paper stack on the tray 42 is allowed to protrude from the top 30a of the upper casing part 30. With this configuration, the copier allows the operator to pick up the paper stack easily”. If the discharge tray 42 were extended to also protrude from above the top of the upper casing part, the paper would no longer be easily picked up because the discharge tray would prevent the user from easily grasping the discharged paper, thereby defeating a stated objective of the Takashima '095 patent. Therefore, the Takashima '095 patent is not properly combinable with the Makiura '093 patent because to do so would defeat a stated objective of the Takashima '095 patent. Thus, there is a disincentive to combine the Takashima '095 and Makiura '093 patent. In re Gordon, 733 F.2d 900 (Fed. Cir. 1984).

With regard to the third embodiment shown in FIG. 9, the Takashima '095 patent does not disclose or suggest a paper discharge tray that forms a substantial portion of the rear wall of the apparatus, as recited in independent claims 1 and 9. Similarly to the discharge tray 10 of the first embodiment, the discharge tray 21 shown in FIG. 9 is disposed *in* the rear portion of the casing. By forming the discharge tray 21 *within* the rear portion of the casing, the discharge tray 21 does not form a substantial portion of the rear wall of the main machine, as recited in independent claims 1 and 9. Furthermore, the Makiura '093 patent does not cure this deficiency in the first embodiment of the Takashima '095 patent as the tray 114 does not form a substantial portion of a rear wall of the main machine.

Claims 7 and 8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Takashima '095 patent in view of the Makiura '093 patent in further view of U.S. Patent No. 3,912,389 to Miyamoto (the Miyamoto '389 patent). The Miyamoto '389 patent is cited for disclosing a door in a rear wall to facilitate clearing paper jams. However, this does not cure

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the deficiencies noted above in the Takashima '095 and Makiura '093 patents with regard to independent claim 1.

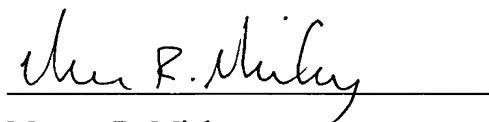
Therefore, the Takashima '095 patent in view of the Makiura '093 patent and in further view of the Miyamoto '389 patent does not anticipate or render obvious Applicants' invention recited in independent claims 1 and 9.

Claims 3 – 8 and 11, being dependent upon independent claims 1 and 9, are also allowable for the above reasons. Moreover, these dependent claims recite additional features further distinguishing them over the cited patents, such as a door installed on a backside wall of claim 7; and the door being hinged to the backside wall of claim 8. Therefore, dependent claims 3 – 8 and 11 are not anticipated or rendered obvious by the cited patents, particularly within the overall claimed combination.

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In view of the foregoing amendment and comments, Applicants respectfully submit that claims 1, 3 – 9 and 11 are allowable over the cited patents. Prompt and favorable action is solicited.

Respectfully Submitted,



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